> function (as in claim 21(k)), and a fragment of ≥ 30 amino acids of SEQ ID NO:2.

(*See,* Paper No. 13, Pages 2-3, Paragraph 3.)

In order to be fully responsive, Applicants hereby elect, with traverse, an isolated protein comprising amino acids 24 to 173 of SEQ ID NO:2 (Claims 21(e), 26, 33, and 35-37). Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the additional restriction requirement be made final. In such a case, Applicants retain the right to petition from the additional restriction requirement under 37 C.F.R. § 1.144.

Applicants respectfully traverse and request the withdrawal of the requirement for further restriction.

As a threshold matter, Applicants point out that MPEP § 803 lists the criteria for a proper restriction requirement:

> Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).
>
> If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the sequences listed by the Examiner represent distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of these sequences would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation no such showing has been made.

The Examiner has alleged that

> Although the classifications for these various proteins are overlapping, for instance 530/300, each represents a patentably distinct product with distinct physical and functional characteristics. Additionally, the burden of search for the Office has increased with multiple sequences because of the rapid introduction of new sequences to public sequence databases. Further the search of more than one product would be burdensome, because some are claimed not by protein sequence, but by the sequence encoded by a nucleic acid sequence, and requires a search of the corresponding region of SEQ ID NO:1 as well as a 'reverse translation' search of the

> corresponding region of SEQ ID NO:2, such that each individual sequence requires two sequence searches which are not required for any of the other sequences; or alternatively by virtue of comprising only a small portion of a disclosed protein, which requires a separate "word search" of the protein and/or nucleic acid databases, or by claiming proteins which are not 100% identical to a disclosed protein, which requires a broader search of the protein databases. Due to the use of 'comprising' language, it cannot even be said that the search for a protein comprising amino acids 1-223 of SEQ ID NO:2 would reveal art pertaining to, for instance, a protein *comprising* amino acids 24-67 of SEQ ID NO:2, as the latter could be found embedded in a completely different protein. Accordingly, restriction is proper.

(*See,* Paper No. 13, Page 3, Paragraph 5, emphasis in original.)

Applicants disagree and submit that an art search with a protein comprising amino acid residues 24 to 173 of SEQ ID NO:2 would be largely overlapping with that for a protein comprising amino acid residues 1-223, 1-173, 24-223, 24-67, 45-128, 68-173, 68-223, 129-207, or 174-223 of SEQ ID NO:2 (including polypeptides $\geq$ 90% identical to those fragments), a fragment of residues 1-223 which retains function, and a fragment of $\geq$ 30 amino acids of SEQ ID NO:2. Thus, the search and examination of all claims which encompass a protein comprising amino acid residues 1-223, 1-173, 24-223, 24-67, 24-173, 45-128, 68-173, 68-223, 129-207, or 174-223 of SEQ ID NO:2 (including polypeptides $\geq$ 90% identical to those fragments), a fragment of residues 1-223 which retains function, and a fragment of at least 30 contiguous amino acids of SEQ ID NO:2 would not entail a serious burden.

In addition, Applicants respectfully remind the Examiner that upon allowance of a generic claim, Applicants will be entitled to the consideration of additional "species" which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. MPEP § 809.02(a).

Thus, Applicants respectfully request that the further restriction within the formerly presented Group I be withdrawn so the restricted subject matter can be examined together.

Applicants respectfully point out that the provisionally elected claim 21(e) is overlapping in scope to the pending claims, particularly given that all of the claims are directed to SEQ ID NO:2 (or the corresponding deposited clone). Nevertheless, to the extent that the Examiner requests that Applicants "point out which claims correspond to the elected

invention" (*see,* Paper No. 13, Page 3), Applicants point out that claims 26, 33, and 35-37 are particularly directed to the provisionally elected subject matter of claim 21(e).

Conclusion

Applicants respectfully request that the above-made remarks be entered and made of record in the file history of the instant application. If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Date: SEPTEMBER 5, 2001

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